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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,698	07/27/2006	Manfred Meinherz	2004P00850	3531

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EXAMINER
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FISHMAN, MARINA

ART UNIT	PAPER NUMBER
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2832

MAIL DATE	DELIVERY MODE
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01/07/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/587,698

Applicant(s)

MEINHERZ, MANFRED

Examiner

Marina Fishman

Art Unit

2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 0727/2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 07/27/2006.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *General status*

1. This is a First Action on the Merits. Claims 12 – 23 are pending in the case and are being examined.

### *Priority*

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12, 15 – 17, 19 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Calvino [US 4,486,633].

Regarding Claims 12 and 19 Calvino discloses a compressed-gas-insulated switch-disconnector module comprising:

- an electrically conductive housing [12] having first and second flanges [44, 72];
- switching contacts [30, 36];
- a main axis [not numbered, Figures 3, 4];

- first and second electrical phase conductors [23, 36] extended along the main axis for connection at an isolating gap;
- the first phase conductor passing through the first flange; the second phase conductor passing through the second flange [Figures 3 and 4];
- a tubular electrode [42] connected to the housing, concentrically surrounding the first phase conductor, disposed radially inside the first flange, and projecting beyond the first flange.

Regarding Claim 15 Calvino discloses a compressed-gas-insulated switch-disconnector module wherein the first and second flanges are annular, and the first flange has a larger circumference than the second flange [Figures 3 and 4]. Regarding Claim 16 the electrode is supported by the housing [Figure 3]. Regarding Claim 17, the limitation "cast onto the housing" is a method step limitation in an article claim, and the disclosed electrode is capable of being cast onto the housing.

Regarding Claim 19, Calvino also discloses insulating casing, flange connected to the housing as an outdoor bushing [20]. Regarding Claim 23, disclosed electrode extends coaxially and shields the connecting area.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13, 14, 18 and 20 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calvino [US 4,486,633] in view of Futura et al. [US 6,538,224].

Regarding Claim 13 Calvino disclose the instant claimed invention including a compressed-gas-insulated switch-disconnector module the first and second flanges are mutually coaxial and disposed at mutually opposite ends of the housing and transformers [7, 8], however does not disclose a toroidal transformer at the second flange. Futura et al. disclose a gas insulation switch gear apparatus having toroidal transformer [70] at the second flange [Figures 10, 12, 13]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the transformer at the second flange in Calvino, as suggested by Futura et al. since it has been held that rearranging parts of an invention involves only routine skill in the art. (in re Jpikse, 86 USPQ 70.). Regarding Claim 14, Futura discloses a frame for the transformer, which is taken as a stub. Regarding Claim 22, Calvino discloses gas area extends into the stub. Regarding Claim 18 Calvino discloses all the elements of claimed invention except for grounding switch. Futura et al. [Figure 5] discloses grounding switch

[41, 42]. It would have been obvious to one of ordinary skill in the art at the time the invention is made to provide a grounding switch in Calvino, as suggested by Futura et al., so as to be able to ground the switch, in case of default and also support the phase conductor, so as to maintain alignment between the stationary and moving contacts.

Regarding claims 20 and 21, Calvino and Futura et al. disclose the instant claimed invention including support [60], except the support disclosed is not a pillar support. The use of the particular type of support absent any criticality, is considered to be nothing more than a choice of engineering skill, choice of design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the support arrangement is able to be support the first conductor, 2) the support arrangement claimed by the Applicant and that disclosed by Calvino and Futura et al. are well known alternate types of support arrangements, which will perform the same function, if one is replaced with the other, and 3) the use of this particular type of support arrangements by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types support arrangements, that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to attach the first conductor to the housing as already suggested by Calvino and Futura et al.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kamata et al. [US 4,468,716], Rokunohe et al. [US 6,680,453], Matsushita et al. [US 6,459,568] all disclose gas-insulated high voltage switchgears. Applicant also should consider these references in


response to this office action. Should issue arise concerning the rejection presented above, these references may be relied upon in a subsequent action to support the lack of novelty or obviousness of claimed subject matter to one of ordinary skill in the art.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Fishman whose telephone number is 571-272-1991. The examiner can normally be reached on 7-5 M-T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marina Fishman  
November 27, 2007

  
ELVIN ENAD  
SUPERVISORY PATENT EXAMINER  
310 EC 07